REMARKS:

This communication is in response to the office action mailed June 15, 2004

(paper 11). Claims 1-35 are pending in this application, Claims 1-33 have been

previously considered and Claims 34 and 35 are new.

Rejections under 35 U.S.C. §102

Claims 1-3, 6-9, 14-17, 23-30, 32 and 33 were rejected under 35 U.S.C. 102(b)

as being anticipated by Henson, US Patent 6,167,383, filed 09/22/1998.

Regarding Claim 1:

Claim 1 recites:
A method for visually configuring a product by placing a plurality of selectable
        components into a plurality of slots, comprising:
        (a) initializing a configuration layout with proper state;
        (b) receiving a selection of one of the plurality of selectable objects, and of one of
                the plurality of slots in which the selected object may be placed;
        (c) providing visual feedback indicating a validity of the selections;
        (d) receiving a placement of the selected object;
        (e) receiving input regarding the placement from a remote inference engine;
        (f) updating the visual feedback as needed based on the received input; and
        (g) repeating steps (b) through (f) until no more selections are received.

At least one difference between limitations of Claim 1 and teachings of Henson is

that while Henson teaches selection of an item from a pull-down menu, Claim 1 recites

both a *"selection"* and a *"placement"* of an object. Specifically, Claim 1 recites *"(b)*

receiving a selection of one of the plurality of selectable objects" and *"(d) receiving a*

placement of the selected object." The Applicants are unable to find teaching of both a

"selection" and a *"placement"* in Henson. It appears that Henson teaches selection of one

item from a plurality of items already within a field, but not *"receiving a placement of the*

selected object." Those items selected are already within the selected field and <u>Henson</u>

does not teach that a user has an ability to separately place an item in a field.

In the rejection of Claim 1, the Examiner takes to position that "Reference sign 76

of Figure 3A [of <u>Henson</u>] discloses the placement of the selected object (shown as 'Hard

5   Drive')." However, the Applicants note that Reference Number 76 is directed to the

header text "Hard Drive ... Help Me Choose" which according to col. 7 lines 27-28 is

"[m]erchandising messaging." According to <u>Henson</u>, merchandising messaging is

"generic text about a particular product, feature, and/or option" (col. 7 lines 28-29).

Thus, it is not clear how generic text about a particular product, feature, and/or option

10   teaches the claimed feature of *"receiving a placement of the selected object"* as suggested

by the Examiner. It is the position of the Applicants that "Hard Drive ... Help Me

Choose" does not teach placement of a selected object, rather it merely teaches that a user

can select (choose) an item from among a set of items already within the field having the

header "Hard Drive." Because there is no placement of a selected object there is no

15   *"receiving a placement of the selected object,"* as recited in Claim 1. The Applicants,

therefore, request that the Examiner specifically point out teachings within <u>Henson</u> that

teach *"(d) receiving a placement of the selected object,"* or allow Claim 1.

Another difference between limitations of Claim 1 and teachings of <u>Henson</u> is that

in Claim 1 a selectable object may be placed in a plurality of alternative slots, while in

20   <u>Henson</u> a selected object merely resides in the one slot within which the object is

selected. Specifically, Claim 1 includes: *"(b) receiving a selection of one of the plurality*

of selectable objects, and of one of the plurality of slots in which the selected object may

be placed." Two selections are received, first *"one of the plurality of selectable objects,"*

and second *"one of the plurality of slots in which the selected object may be placed."* The second selection is made from a *"plurality of slots in which the selected object may be placed."* Thus, in Claim 1 the selected object may be placed in a plurality of slots. The Examiner is referred to FIGs. 3 and 6 of the specification as filed for one example of an

5   object (310) being placed in two different slots.

In contrast, as illustrated in Figs. 3A-3B of <u>Henson</u>, each element of a configuration (e.g., 96MB SDRAM or 16.8GB 5400rpm Ultra ATA Hard Drive) appears to be associated with one particular field within configuration options screen 70. For example, the field "Memory" includes an element of "96MB SDRAM" and the field

10   "Monitor" includes a "1000HS 17" (16.0" vis .26dps) Trinitron Monitor." <u>Henson</u> does not appear to teach that the "96MB SDRAM" could be placed in the Monitor field or that the "1000HS 17" (16.0" vis .26dps) Trinitron Monitor" could be placed in the Memory field. The Applicants are unable to identify any teaching within <u>Henson</u> that suggests that a user can "place" or "move" an item. Each selectable element taught in <u>Henson</u> is

15   already in a field and cannot be placed in another field. Thus, <u>Henson</u> does not teach a *"plurality of slots in which the selected object may be placed,"* as recited in Claim 1.

The Applicants are unable to identify any discussion of these differences between Claim 1 and the cited art in the current office action. The Applicants, therefore request that the Examiner specifically point out teaching of *"(b) receiving a selection of one of*

20 . *the plurality of selectable objects, and of one of the plurality of slots in which the selected object may be placed,"* or allow Claim 1 and those claims dependent therefrom. The Applicants also note that the above arguments apply to independent Claims 2, 12, 14, 15, and 16.

For at least the above reasons the Applicants request that the Examiner allow

Claim 1 and Claims 33 and 34 that depend therefrom.

Regarding Claim 2:

5   Claim 2 recites:

A method for visually configuring a product by placing a plurality of selectable
*   components into a plurality of slots, comprising:*
*   (a) initializing a configuration layout with proper state;*
*   (b) receiving a selection of one of the plurality of selectable objects, and of one of*
10   *   the plurality of slots in which the selected object may be placed;*
*   (c) looking up a set of constraints on the placement of the selected object;*
*   (d) receiving a placement of the selected object;*
*   (e) receiving input regarding the placement from a remote inference engine;*
*   (f) implementing the received input;*
15   *   (g) storing a new set of constraints based on the placement of the selected object;*
*   and*
*   (h) repeating steps (b) through (g) until no more selections are received.*

It is the Applicants' position that Claim 2 should be allowed for the same reasons

20   discussed above with respect to Claim 1. Specifically, <u>Henson</u> does not teach a *"plurality*

of slots in which the selected object may be placed," and *"receiving a placement of the*

selected object."

In addition, Claim 2 recites, *"(g) storing a new set of constraints based on the*

placement of the selected object." In reference to this claim element the Examiner states

25   "Henson discloses storing the new set of restraints, as shown by the 'Save My Cart'

button shown in Figure 6, at reference sign 106." It is the position of the Applicants that

the "Save My Cart" button illustrated in Figure 6 of <u>Henson</u> does not teach *"storing a*

new set of constraints." Rather, <u>Henson</u> teaches that the cart contains items for purchase.

For example, at col. 10 lines 52-54, <u>Henson</u> teaches "A user can place an item into the

30   cart, back out of the store, re-enter and place another item in the cart..." The Applicants

are unable to identify any teaching within <u>Henson</u> that constraints, associated with placement of a selected item, are included in the cart. An item, even an item having a selected configuration, is not a constraint or set of constraints. Therefore, a teaching that a cart including items can be saved does not teach *"storing a new set of constraints,"*

5   much less *"constraints based on the placement of the selected object,"* as recited in Claim 2. The Applicants, therefore, request that the Examiner identify teaching that constraints are saved using the "Save My Cart" button, or allow Claim 2 and Claims 3-8 that depend therefrom.

10   **Regarding Claims 3 and 6-8:**

It is the Applicants' position that Claims 3 and 6-8 should be allowed for at least the same reasons discussed above with respect to Claim 2.

Regarding Claim 9:

15   *Claim 9 recites:*
A system for visually configuring a product from a plurality of selectable components, comprising:
a user interface for displaying the plurality of selectable components and a plurality of slots into which the plurality of selectable
20   *components can be placed; and*
a user intelligence communicatively coupled to the user interface, for receiving a set of constraints from a remote inference engine and implementing the set of constraints.

25   It is the Applicants' position that Claim 9 should be allowed for at least reasons discussed above with respect to Claim 1. Specifically, <u>Hanson</u> does not teach *"a plurality of slots into which the plurality of selectable components can be placed."*

In addition, Claim 9 recites, "*a user intelligence communicatively coupled to the user interface, for receiving a set of constraints from a remote inference engine.*" With regard to these limitations, the Examiner states

5   Henson further recites: "*According to one embodiment, a web-based online store having a user interface for enabling a custom configuration of a computer system according to an identification of a user belonging to a prescribed customer set includes a configurator, a cart, a checkout, and a database. The configurator is provided for configuring a computer system with options selected according to a prescribed user input*" (column 2, lines 61-65) (emphasis in original)

10

It is not clear to the Applicants how the Examiner believes this text teaches the above claim limitations. Specifically, it is not clear to the Applicants which aspect of the text is thought to teach "a user intelligence." The configurator, a cart, a checkout, and database are taught to be server side features of Henson's system in Figs. 1 and 2.

15   However, the specification as filed makes clear that "[t]he user intelligence 140 performs the functions of sending data to the inference engine 170..." (pg 10 lines 13-15) and that this communication is "from the client device 910 to the remote server 920" (page 17 line 21). Thus, the elements of Henson cited by the Examiner cannot be "*user intelligence.*" If anything, they would be suggestive of "server side intelligence" which is characterized

20   on page 10 line 4-5 of the specification as filed.

Further, if for the sake of argument, the configurator, a cart, a checkout, or database did teach the "*user intelligence,*" then it would not be clear to the Applicants which aspect of the cited text is thought to teach the "*remote inference engine*" recited in "*a user intelligence ..., for receiving a set of constraints from a remote inference*

25   *engine.*" Neither the *configurator, cart, checkout, nor database* appears to be remote from each other, and, therefore, cannot be remote from the "*user intelligence.*" Thus, they cannot teach a "*remote inference engine.*" Therefore, it is the position of the

Applicants that if the cited text teaches the *"user intelligence,"* then the cited text does not teach a *"remote inference engine."*

The Applicants request that the Examiner more specifically point out which aspects of the cited art teach each limitation of Claim 9, or allow Claim 9 and Claims 10 and 11 that depend therefrom.

Regarding Claim 14:

It is the Applicants' position that Claim 14 should be allowed for at least the same reasons discussed above with respect to Claim 1.

Regarding Claim 15:

It is the Applicants' position that Claim 15 should be allowed for at least the same reasons discussed above with respect to Claim 2.

Regarding Claim 16:

Claim 16 recites:

16. A method of visually configuring a product by placing one or more of a plurality of objects into one or more slots, subject to a plurality of configuration rules, the method comprising:
(a) providing the plurality of objects and a predetermined product configuration layout to a client device for display within a graphical user interface, the product configuration layout including the one or more slots;
(b) receiving, from the client device, a selection of one of the plurality of objects displayed within the graphical user interface and a selection of one of the one or more slots, the selection of the one of the plurality of objects and the selection of one of the one or more slots being for modification of the product configuration layout;
(c) causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot, if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules; and

> *(d) causing the graphical user interface to show the selected object within the
> selected slot, if placing the selected object in the selected slot would not
> violate any of the plurality of configuration rules.*

5   It is the Applicants' position that Claim 16 should be allowed for at least reasons

similar to those discussed above with respect to Claim 1. Specifically, <u>Henson</u> does not

teach a *"slots in which the selected object may be **placed**,"* (Claim 1) and therefore does

not teach *"indicat[ing] that the selected object cannot be **placed** in the selected slot"*

(Claim 16).

10   With respect to Claim 16 the Examiner states "Henson further discloses in Figure

3A, an indication that the selected object is not compatible with the current configuration

at reference sign 86, and an indication that the selected object is compatible with the

selected configuration at reference sign 77." It is the Applicants' position that the

teachings cited in Figure 3A do not teach *"(c) causing the graphical user interface to*

15   *indicate that the selected object cannot be placed in the selected slot, if placing the*

selected object in the selected slot would violate one or more of the plurality of

configuration rules," as recited in Claim 16. Specifically, the indications recited in the

above claim elements occur <u>prior</u> to placement of *"the selected object"* in *"the selected*

slot." The Examiner is directed to the language *"if placing the selected object in the*

20   *selected slot <u>would</u>"* in Claim 16. The words *"if"* and *"would"* characterize determination

of consequences of a future action. An advantage of prior indication is seen in FIGs. 3

and 6 of the specification, wherein indication is provided while a user is dragging a

selected object toward a slot. In contrast, Fig. 3A of <u>Henson</u> shows a notice if

incompatibility <u>after</u> an option has been chosen. This is a significant disadvantage of

25   <u>Henson</u> because the user only receives notice after having taken the trouble of choosing

the option. Therefore, the Applicants respectfully request that the Examiner point out

teachings within <u>Henson</u> that teaches these aspects of Claim 16 or allow Claim 16 and

Claims 17-23 and 35 that depend therefrom.

5   **Regarding Claim 17:**

Claim 17 recites:

17. The method of claim 16, wherein the plurality of configuration rules allow a finite
    number of valid product configuration layouts.

10   With respect to Claim 17 the Examiner states:

        Henson recites: *"Option details 76 provide an ability to link form the configurator*
        to more specific detailed information about the system selection options
        presented. Links are made possible at each point where a system option selection
        was possible to aid in the choosing of the correct option from displayed
15   *alternatives"* (column 7, lines 48-53, (compare *"finite number of product*
        configuration layouts" to *"each point where a system option selection was*
        possible").

        The Applicants understand this statement to indicate that the Examiner believes

20   that the statement "each point where a system option selection was possible" teaches a

"finite number of product configuration layouts," as recited in Claim 17. The Applicants

traverse this suggestion. That there are points where a selection is possible does not teach

anything about the number of possible configurations that may result from the selections.

Either an infinite number of decision points or an infinite number of options at one

25   decision point would result in an infinite number of configurations. Further, the

Applicants are unable to identify any teaching within <u>Henson</u> that configuration rules are

related to a finite number of valid configurations or that the configuration rules *"allow"*

each point where a system option selection was possible." The Applicants, therefore,

request that the Examiner clarify how "each point where a system option selection was

possible" teaches a "*finite number of product configuration layouts*," and how this finite

number is allowed by configuration rules, or allow Claim 17.

Regarding Claim 23:

5 Claim 23 recites:

23. The method of claim 16 wherein the configuration layout is representative of a physical layout of the product.

With Respect to Claim 23 the Examiner states "Henson discloses in Figure 3A, at

10 reference sign 70, a configuration layout which represents the physical layout of the

product (shown as an image in the upper left hand corner)." The Applicants traverse this

statement.

First, Fig. 3A shows configuration elements in the following order "Memory,"

"Hard Drive," "Monitor," "Video Card" "CD-Rom Drive," "Sound Card," "Speakers,"

15 "Storage Products," etcetera. There is no teaching within <u>Henson</u> that this is a

representation of the physical order of these elements in the computer product being

purchased. It is the Applicants position that arranging these elements in this order within

a computer would be a non-functional arrangement.

Second, the Applicants are unable to find any teaching that the image shown in

20 the upper left hand corner of Fig. 3A is anything more than a generic and static

representation of a computer. For example, there does not appear to be any teaching that

the image changes in response to changes in the physical layout as a consequence of user

selections. In addition, several options do not appear to be represented in this image

(e.g., the Memory, Hard Drive, Video Card, Video Card and Speakers). Those options

25 that are shown in the image do not seem to be in the order suggested by the order of

configuration elements. For example in the image, it appears that there is a hard drive at the top of the computer tower, while the Hard Drive option is second in the order of configuration elements.

The Applicants, therefore, request that the Examiner allow Claim 23.

Regarding Claim 24:

Claim 24 recites:

24. (Previously Presented) A method of visually configuring a product by placing one or more of a plurality of objects into a slot, the method comprising:

providing a product configuration layout to a client device for display within a graphical user interface, the product configuration layout including a slot for placement of one of the plurality of objects;

providing the plurality of objects to the client device for display within the graphical user interface;

receiving, from the client device, a selection of one of the plurality of selectable objects for placement within the slot;

causing the graphical user interface to show the selected selectable object within the slot if the selected object can be placed in the slot without violating a configuration rule; and

causing the graphical user interface to indicate that the selected object cannot be placed in the slot, if placing the selected object in the selected slot would violate the configuration rule.

It is the Applicants' position that Claim 24 should be allowed for at least reasons similar to those discussed above with respect to Claim 1. Specifically, Henson does not teach a "*a slot for placement of one of the plurality of objects,*" and "*plurality of selectable objects for placement within the slot.*"

With respect to Claim 24 the Examiner states "Henson further discloses in Figure 3A, an indication that the selected object is not compatible with the current configuration at reference sign 86, and an indication that the selected object is compatible with the selected configuration at reference sign 77."

However, the Applicants respectfully point out that Claim 24 recites *"causing the graphical user interface to indicate that the selected object cannot be placed in the slot, if placing the selected object in the selected slot would violate the configuration rule,"* and not "an indication that the selected object is not compatible with the current

5   configuration" as suggested by the Examiner. Further, it is the position of the Applicants that the teaching cited by the Examiner directly contradicts this claim element because in Henson the item is already in the data field, while according Claim 24 *"the selected object **cannot** be placed in the slot."*

It is further the Applicants' position that Claim 24 is allowable for at least reasons

10   similar to those made above with respect to Claim 16. Specifically, Claim 24 recites an indication *"that the selected object cannot be placed in the slot, if placing the selected object in the selected slot would violate the configuration rule."* This is an indication regarding consequences of a future event rather than a past event as in the teachings cited by the Examiner. The Applicants, therefore, request that the Examiner allow Claim 24

15   and Claims 25-28 that depend therefrom.

It is the Applicants' position that Claim 25 should be allowed for at least reasons similar to those discussed above with respect to Claim 1. Specifically, Henson does not teach a *"configuration layout including a slot for placement of one of the plurality of objects,"* and *"receiving, from the client device, a selection of one of the plurality of*

20   *selectable objects for placement within the slot,"* as recited in Claim 25.

Regarding Claims 25, 26 and 27:

It is the Applicants' position that Claims 25, 26 and 27 are allowable for at least the reasons discussed above with respect to Claim 24.

Regarding Claim 28:

It is the Applicants' position that Claim 28 is allowable for at least the reasons

discussed above with respect to Claim 24 and also Claim 23.

5

Regarding Claim 29:

Claim 29 recites:
29. *A method of configuring a product for purchase, the method comprising:*
> *selecting the product for purchase, the product having a plurality of alternative*
10 *configurations, the plurality of alternative configurations being limited by*
> *a plurality of configuration rules;*
> *viewing a first configuration of the plurality of alternative configurations and a*
> *plurality of objects, within a graphical user interface, the viewed first*
> *configuration including one or more slots within which at least one of the*
15 *plurality of objects may be placed;*
> *specifying a second configuration of the selected product by selecting a first of the*
> *plurality of objects for placement in a first of the one or more slots, the*
> *placement of the first of the plurality of objects in the first of the one or*
> *more slots being limited by a subset of the plurality of configuration rules,*
20 *the selection of the first of the plurality of objects being made using the*
> *graphical user interface.*

It is the Applicants' position that Claim 29 should be allowed for at least reasons

similar to those discussed above with respect to Claim 1. Specifically, <u>Henson</u> does not

25 teach "*slots within which at least one of the plurality of objects may be placed*," and

"*selecting a first of the plurality of objects for placement in a first of the one or more*

slots."

With respect to Claim 29 the Examiner states "Henson discloses in Figure 3A, at

reference sign 75 a subset of the configuration rules, in response to the selection of an

30 object (as shown at reference sign 77)." Reference sign 75 is directed at what appears to

be a generic textual description of the configuration category "Hard Drive," while

reference sign 77 is directed at what appears to be a configuration category "Memory" including a selected option "96MB SDRAM". It is not clear to the Applicants how this teaches "*a subset of the plurality of configuration rules*," as suggested by the Examiner. The referenced item does not appear to be a configuration rule much less a subset of

5 configuration rules. Rather, it appears to be a static textual description of a characteristic of all options for a particular field. Applicants are unable to find any teaching of a subset of configuration rules within <u>Henson</u>. Further, the referenced static text does not appear to be in response to "*selecting a first of the plurality of objects for placement in the first of the one or more slots*," as recited in Claim 29.

10 Thus, the static text (77) of Henson does not appear to be a configuration rule, or a subset of a configuration rule, much less also a responsive to a selection. Therefore, the Applicants request that the Examiner specifically point out how <u>Henson</u> teaches all of the limitations of Claim 29 or allow Claim 29 and Claims 30-31, which depend therefrom.

15 **Regarding Claim 30:**

Claim 30 recites:
30. The method of claim 29, wherein the subset of the plurality of configuration rules is determined based on the first configuration.

20 It is the Applicants' position that Claim 30 is allowable for at least the reasons discussed above with reference to Claim 29. The Applicants are unable to identify any teaching within <u>Henson</u> concerning determination of a subset of configuration rules, much less a teaching that this determination is "*based on the first configuration.*"

The Applicants request that the Examiner specifically point out how <u>Henson</u>

25 teaches all of the limitations of Claim 30.

Regarding Claim 32:

Claim 32 recites:

32. The method of claim 29, wherein the plurality of alternative configurations includes a finite number of alternative configurations, the finite number being determined in part by the plurality of configuration rules.

It is the Applicants' position that Claim 32 is allowable for at least the reasons discussed above with reference to Claim 29, and also Claim 17. Applicants are unable to identify any teaching in <u>Henson</u> of a number of configurations being determined in part by a plurality of configuration rules.

Regarding Claim 33:

It is the Applicants' position that Claim 33 is allowable for at least the reasons discussed above with respect to Claim 1.

35 U.S.C. § 103 Rejections

Claims 4, 5, 11-13 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson.

Regarding Claims 4 and 5:

Claim 4 recites:

4. The method of claim 2, wherein the step of looking up constraints comprises looking up a forward-looking rules table.

Claim 5 recites:

5. The method of claim 4, wherein the step of storing a new set of constraints comprises storing a new forward-looking rules table.

Regarding Claims 4 and 5 the Examiner states:

> [I]t would have been obvious, to one of ordinary skill, at the time the invention was made to describe the database feature of Henson as having a forward looking

rules tables because the data base provides "the data base is provided for dynamically supplying configuration options to the configurator" (Henson, column 3, lines 9-10).

5   The Applicants traverse this statement. In <u>Henson</u> configuration conflicts are

detected <u>after</u> they occur. See for example, item 86 on Fig. 3A. This application of

constraints is "backward-looking." In contrast, a

> "[F]orward-looking rules table [of the invention] is created based on the
> components selected by the user, and their placements. Based on each new
10   selection an placement by a user, a new forward-looking rues table is created
> which lists the constraints on the *next* selection by the user. That is, the forward-
> looking rules table identifies which slots may or may not be occupied by which
> particular objects in the next selection by the user. (specification as filed page 11,
> emphasis in original).

15
The Applicants are unable to find any teaching in <u>Henson</u> of constraints being applied

"forward" before a configuration change has been made. It is, therefore, the Applicants'

position that the constraints taught in <u>Henson</u> are not forward looking. There would,

therefore, be no reason to employ a *"forward-looking rules table"* as recited in Claims 4

20   and 5. In contrast to the Examiner's statement, a database provided for dynamically

supplying configuration options may use a backward-looking rules table and, thus, does

not necessarily teach a *"forward-looking rules table."* It is the position of the Applicant

that the use of a forward-looking rules table is, therefore, not obvious. Rather, the fact

that <u>Henson</u> teaches displaying a warning message *after* an option has been selected

25   teaches away from use of a forward-looking rules table.

The Applicants respectfully request that the Examiner provide support for the

assumption that the use of forward-looking tables are obvious, or allow Claims 4 and 5.

Applicants note that the above arguments also apply to Claims 11, 12 and 18.

Regarding Claim 11:

Claim 11 recites:

11. The system of claim 9, wherein the user intelligence comprises:
*   an interpretor for receiving a set of constraints from an inference engine;*
5   *a storage for storing the set of constraints;*
*   an implementor for implementing the forward-looking rules stored in the table;*
*   and*
*   an encoder for encoding and sending data regarding a user's current selection*
*   from the plurality of donors and the plurality of receptors to the inference*
10   *engine.*

With respect to Claim 11 the Examiner states:

[I]t would have been obvious, to one of ordinary skill, at the time the invention
was made to describe the database feature of Henson as having a forward looking
15 rules tables because the data base provides "the data base is provided for
dynamically supplying configuration options to the configurator" (Henson,
column 3, lines 9-10).

Applicants traverse this statement for the reasons discussed above with respect to

20 Claims 4 and 5.

Applicants also note that the Examiner's statement does not appear to discuss the

"interpertor," "implementor," or *"encoder"* recited in Claim 11. The Applicants,

therefore, request that the Examiner specifically point out those sections of Henson that

he believes teach these elements of Claim 11.

25   In addition, it is the Applicants position that Claim 11 is allowable for at least the

reasons discussed above with respect to Claim 9.

Regarding Claim 12:   o

Claim 12 recites:
30 *A system for visually configuring a product from a plurality of selectable components,*
*   comprising:*
*   on a client device:*

a visual user interface for displaying the plurality of selectable
components and a plurality of slots into which the plurality of
selectable components can be placed;
a user intelligence communicatively coupled to the visual user interface
5 *for determining, by using a forward-looking rules table, the*
validity of placement of one of the plurality of selectable
components into one of the plurality of slots; and
on a remote host device:
an inference engine communicatively coupled to the user intelligence, for
10 *storing rules and constraints governing placement of the plurality*
of selectable components, and for generating the forward-looking
rules table.

With respect to Claim 12 the Examiner states on page 13 of the current office

15 action:

[I]t would have been obvious, to one of ordinary skill, at the time the invention
was made to describe the database feature of Henson as having a forward looking
rules tables because the data base provides "the data base is provided for
dynamically supplying configuration options to the configurator" (Henson,
20 column 3, lines 9-10).

Applicants traverse this statement for the reasons discussed above with respect to

Claims 4 and 5.

Further, Claim 12 recites, "*a user intelligence communicatively coupled to the*

25 *visual user interface for determining, by using a forward-looking rules table, the validity*

of placement of one of the plurality of selectable components into one of the plurality of

slots." With regard to this claim element, the Examiner states in the comment on pages

13-14 of the current office action:

Henson discloses visually configuring a product from a plurality of selectable
30 components, with a user interface for selecting components and slots, and
intelligence for determining object placement validity; and an online store for
storing the rules and constraints for object placement as described above. Henson
fails to explicitly describe a client device or a remote host device. However,
Henson discloses in Figure 2, a client (at reference sign 40) connected remotely
35 via the Internet (at reference sign 38) to a remote host (at reference sign 10,
described as "On-Line Store").

The Applicants note that Figs. 1 and 2 of <u>Henson</u> appear to teach that constraints are applied at the "On-Line Store" which is a server system not a user system. This teaches away from the claim limitation, which recites "*a user intelligence,*" as opposed to "a server intelligence". The Examiner is referred to the arguments made above with

5   respect to "user intelligence" in regard to Claim 9. In the context of <u>Henson</u>, "*a user intelligence*" would be on the client labeled 40 in Fig. 2. It is, therefore, the Applicants' position that the claimed arrangement, including a "*user intelligence,*" is not taught in <u>Henson</u>. The Applicants, therefore request that the Examiner specifically point out teaching of this limitation within <u>Henson</u>, or allow Claim 12.

10   It is the Applicants' position that Claim 12 should also be allowed for at least reasons discussed above with respect to Claim 1. Specifically, <u>Henson</u> does not teach "*a plurality of slots into which the plurality of selectable components can be placed.*"

Regarding Claim 18:

15   Claim 18 recites:
     18. The method of claim 16 wherein a forward-looking rules table is used to determine if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules.

20   It is the Applicants position that Claim 18 is allowable for at least the reasons discussed above with respect to Claim 16, and also Claims 4 and 5.

Regarding Claim 19:

Claim 19 recites:
25   *19. The method of claim 16 wherein a user intelligence stored on the client device is used to determine if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules.*

With regard to Claim 19 Examiner states:

Henson discloses visually configuring a product from a plurality of selectable components, with a user interface for selecting components and slots, and intelligence for determining object placement validity; and an online store for storing the rules and constraints for object placement as described above. Henson fails to explicitly describe a client device or a remote host device. However, Henson discloses in Figure 2, a client (at reference sign 40) connected remotely via the Internet (at reference sign 38) to a remote host (at reference sign 10, described as "On-Line Store").

The Applicants note that Figs. 1 and 2 <u>Henson</u> appear to teach that constraints are applied at the "On-Line Store" which is a server system not a user system. This teaches away from the claim limitation, which recites "*a user intelligence <u>stored on the client device</u>*". In contrast to Claim 19, <u>Henson</u> teaches a "client 40" shown in Fig. 2 that is separated from On-line Store 10 by Internet 38. <u>Henson</u> further teaches, in Fig. 1, that features that manage configurations are included in On-Line Store 10. It is, therefore, the Applicants' position that <u>Henson</u> specifically teaches away from the limitations of Claim 19.

The Applicants also believe that Claim 19 is allowable for the reasons discussed above with respect to Claim 16.

Regarding Claim 20:

It is the Applicants position that Claim 20 is allowable for at least the reasons discussed above with regard to Claim 16.

Regarding Claim 13:

It is the Applicants position that Claim 13 is allowable for at least the reasons discussed above with regard to Claim 12.

Claims 10, 21, 22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King et al. US Patent 6,161,114 (filed 4/14/1999).

5   **Regarding Claims 10, 21, 22 and 31:**

With respect to these claims the Examiner States on page 14 of the current office action:

> [I]t would have been obvious, to one of ordinary skill, at the time the invention was made, to use the drag and drop teachings of King to enhance the object
10   selection function of Templeman to allow user the ability to "improve document product" (King, Column 6, line 7).

It is the position of the Applicants that this statement is inapplicable to the rejection of Claims 10, 21, 22 and 31 under 35 U.S.C. 103(a) as being unpatentable over

15   Henson in view of King. The Applicants assume that the Examiner intends to refer to Henson rather than to "Templeman" as stated at the bottom of page 14 of the current office action.

It is the position of the Applicants' that the Examiner does not provide motivation for the combination of King and Henson. The only suggestion of a motivation is "to

20   'improve document production.'" However, "improved document production" is not a goal of Henson and, therefore, one would not think to look to King to achieve such an objective. Therefore, this motivation does not support the combination of art as suggested by the Examiner under 35 U.S.C. 103(a). Without providing a proper motivation to combine, the Examiner has not made a prima facie case for a rejection

25   under 103(a). The Applicants also note that if motivation is provided in a subsequent

office action this would constitute a new argument and, thus, preclude issuance of a Final

Office Action.

Specifically with regard to Claim 10: Applicants are unable to identify teaching

of *"donors"* or *"receptors"* (as distinguished from objects and slots) in either King or

5   Henson. Applicants request that the Examiner specifically point out these teachings or

allow Claim 10.

Specifically with regard to Claim 22: Applicants are unable to identify teaching

of *"wherein causing the graphical user interface to indicate that the selected object*

cannot be placed in the selected slot includes not allowing the dragging one of the

10   *plurality of object to be dropped in the one of the one or more slots,"* as recited in Claim

22, in either King or Henson. Applicants request that the Examiner specifically point out

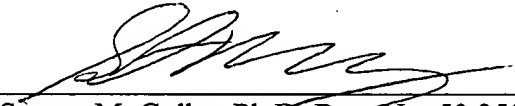these teachings or allow Claim 22

New Claims

15   New Claims 34 and 35 are dependent on Claims 1 and 16 respectfully. Each

recites further limitations that the Applicants believe are not taught by Henson. Support

for Claims 34 and 35 may be found in the specification as filed on page 13 lines 5-21,

among other places.

Applicants believe that all pending claims are allowable and respectfully request

that the Examiner issue a Notice of Allowance. Should the Examiner have questions, the

5   Applicants' undersigned representative may be reached at the number provided.

                                        Respectfully submitted,

                                        Christopher E. Axe et al.

10
     Date: September 15, 2004

                                        Steven M. Colby, Ph.D. Reg. No. 50,250

                                        Carr & Ferrell *LLP*
                                        2200 Geng Rd.
15   Palo Alto, CA 94303
                                        Phone (650) 812-3400
                                        Fax (650) 812-3444